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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,502	01/27/1999	YOSHIKAZU KOBAYASHI	Q52863	6211

7590 05/22/2003

SUGHRUE MION ZINN MACPEAK AND SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037

EXAMINER

TRAN, CON P

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 05/22/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/238,502

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Con P. Tran

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayless et al. (5,754,636) in view of Coad et al. (5,966,652).

Regarding **claims 1-4, 10, 12, and 14**, Bayless et al. teaches a telephone call dialing method, for use in an information terminal with an operating system (see Fig. 20, 21, 22, 23, 25, and respective portions of the specification), which can display a plurality of windows (see col. 21, lines 12-22), comprising the steps and means of:

selecting a string of character information in a window displayed by the operating system, and storing the selected string of character information in a common working memory, which is shared by the operating system (see col. 15, line 62 – col. 16, line 3, col. 22, lines 35-43);

call dialing control means (558) for controlling the operation of call dialing based upon the telephone number output from the output means, to the line (see col. 36, lines 61-67).

selected piece of character information is stored in a common working memory, which is shared by the operating system (see col. 15, line 62 – col. 16, line 3).

selected string of character information is one selected by a regional designation, and then stored in a common working memory, which is shared by the operating system (see col. 15, lines 42-61).

Bayless et al. also teaches the information stored in custom dial plan window 262 can display dial string 278 that will be dialed when the user makes a call (Fig. 20, col. 21, lines 4-5). However, Bayless et al. reference does not explicitly disclose to extract a telephone number from the stored string of character information. Thus one of ordinary skill would have been motivated to seek an embodiment in order to provide an actual working system taught by Bayless et al. Such embodiments would have been any known system such as one of Coad et al. in the same field of endeavor.

Coad et al. teaches a text parser 124 (Fig. 4) separates the call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in the memory 116 (see col. 7, lines 32-37) in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (see col. 3, lines 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Bayless et al. reference steps and means to extract a telephone number from the stored string of character information; and call dialing based upon the extracted telephone number, to a line as taught by Coad et al. in order to advantageously permit the transmission of one or more

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embedded call-back telephone numbers that are embedded into a text message as suggested by Coad et al. in column 3, lines 21-23.

Regarding **claims 5-9, 11, 13, and 15-19**, Bayless et al. teaches a telephone call dialing method, for use in an information terminal with an operating system (see Fig. 20, 21, 22, 23, 25, and respective portions of the specification), which can display a plurality of windows (see col. 21, lines 12-22), comprising the steps and means of:

- displaying a first window (288; see col. 21, lines 40-67);

- selecting a string of character information in a second window (282) displayed by the operating system on display application means (72), and storing the selected string of character information (see col. 22, lines 35-54) for assistance in controlling a call dialing operation (see col. 21, lines 40-67);

- call dialing control means (558) for controlling the operation of call dialing based upon the telephone number output from the output means, to the line (see col. 36, lines 61-67).

- selection means (64, 66) for selecting a string of character information in a second window displayed by the operating system (see col. 21, lines 40-50);

- storage means (60, 62) for storing the selected string of character information (see col. 8, lines 42-48);

- output means for outputting the telephone number in order to call-dial to a line (see col. 8, lines 6-14 and col. 21, lines 12-34).

- entering a telephone number from the stored string of character

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information (see col. 22, lines 35-43);

displaying the telephone number in the first window (see col. 21, lines 40-67); and

call dialing based upon the telephone number, to a line (see col. 21, lines 4-11).

Bayless et al. also teaches the information stored in custom dial plan window 262 can display dial string 278 that will be dialed when the user makes a call (Fig. 20, col. 21, lines 4-5). However, Bayless et al. reference does not explicitly disclose to extract a telephone number from the stored string of character information. Thus one of ordinary skill would have been motivated to seek an embodiment in order to provide an actual working system taught by Bayless et al. Such embodiments would have been any known system such as one of Coad et al. in the same field of endeavor.

Coad et al. teaches a text parser 124 (Fig. 4) separates the call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in the memory 116 (see col. 7, lines 32-37) in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (see col. 3, lines 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Bayless et al. reference steps and means to extract a telephone number from the stored string of character information; and call dialing based upon the extracted telephone number, to a line as taught by Coad et al. in order to advantageously permit the transmission of one or more

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embedded call-back telephone numbers that are embedded into a text message as suggested by Coad et al. in column 3, lines 21-23.

Regarding **claims 20 and 21**, Bayless et al. in view of Coad et al. further teaches the information terminal according to claim 11, wherein when the display application means sets the first window to a tool bar display form (see Bayless, col. 21, lines 40-50), the extraction means does not extract the telephone number from the character information (see Bayless, col. 19, lines 38-45).

Regarding **claim 22 and 23**, Bayless et al. teaches a recording medium (60, 62; see Fig. 22, 24, 25, and respective portions of the specification), which stores a program to be executed by a computer, wherein the program includes:

- a procedure for displaying a first window (288), which assists a telephone call dialing operation (see col. 21, lines 40-67);

- a procedure for selecting a string of character information in a window displayed by the operating system, and storing the selected string of character information (see col. 21, lines 35-50 and col. 22, lines 26-43);

- a procedure for entering a telephone number from the stored string of character information (see col. 22, lines 26-43); and

- a procedure for call dialing based upon the entered telephone number, to a line (see col. 21, lines 4-22).

Bayless et al. also teaches the information stored in custom dial plan window 262 can display dial string 278 that will be dialed when the user makes a call (Fig. 20, col. 21, lines 4-5). However, Bayless et al. reference does not explicitly disclose to extract a telephone number from the stored string of character information. Thus one of ordinary skill would have been motivated to seek a procedure in order to provide an actual working system taught by Bayless et al. Such procedure would have been any known procedure such as one of Coad et al. in the same field of endeavor.

Coad et al. teaches a text parser 124 separates the call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in the memory 116 (see col. 7, lines 32-37) in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (see col. 3, lines 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Bayless et al. reference procedure to extract a telephone number from the stored string of character information; and call dialing based upon the extracted telephone number, to a line as taught by Coad et al. in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message as suggested by Coad et al. in column 3, lines 21-23.

Response to Arguments

3. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground of rejection.

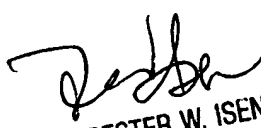
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran, whose telephone number is (703) 305-2341. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office at telephone number (703) 306-0377.

cpt CPJ
May 18, 2003


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600